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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/891,484	06/25/2001	Wade Lee	13.041	9387
9651	7590	02/22/2005	EXAMINER	
ELLIOT B. ARONSON 5001 HARBORD DRIVE OAKLAND, CA 94618			COURSON, TANIA C	
			ART UNIT	PAPER NUMBER
			2859	

DATE MAILED: 02/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/891,484

Applicant(s)

LEE, WADE

Examiner

Tania C. Courson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 17 November 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 2-5,8,9 and 11-15 is/are pending in the application.
- 4a) Of the above claim(s) 6,7 and 10 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 2-5,8,9 and 11-15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 June 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Election/Restrictions*

1. The election requirement stated in a previous office action (Paper No. 5) is hereby repeated, and thus maintained **FINAL**.
2. Claims 6-7 and 10 are maintained withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected group, there being no allowable generic or linking claim. Election was made, for the species shown in Figs. 1 and 2a, **without** traverse in Paper No. 5.

### *Claim Rejections - 35 USC § 103*

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 9 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kito et al. (US 4,421,560) in view of Parker (US 3,893,340) and Telatemp (see Attachment #1, website dated October 12, 1999).

Kito et al. disclose a thermochromic label indicator including the following:

- a) a transparent protective covering (column 14, lines 62-68) disposed in a readily visible location at at least one exterior surface (column 37, lines 62-66), a layer of thermochromic coating composition disposed between said transparent protective covering and said at least one exterior surface (column 15, lines 15-20), wherein said layer of thermochromic coating composition is in communication with at least a portion of said at least one exterior surface (column 37, lines 49-66) and is formulated to undergo a conspicuous color change in response to heat from said at least one exterior surface during normal operation of an appliance (column 2, lines 63-66);
- b) further comprising indicia (column 14, lines 55-56), wherein said layer of thermochromic coating composition is disposed so as to cover said indicia (column 14, lines 51-61) and wherein said layer of thermochromic coating composition is normally opaque at room temperature so as to substantially obscure said indicia and turns transparent in response to heat from at least one exterior surface so as to expose said indicia (column 2, lines 63-66 and column 14 line 66 through column 15, line 15).

Kito et al. do not disclose a thermal moderator disposed between a thermochromic composition and at least one exterior surface and wherein said thermochromic composition is in thermal communication with at least a portion of said at least one exterior surface through said thermal moderator and wherein a conspicuous color change reveals an indication that at least one exterior surface is of a temperature hot to human touch and wherein indicia is a warning indicia

Parker teaches a thermally insulated warning indicator that consists of a thermal moderator (Fig. 4, insulator 20) disposed between a thermochromic composition (Fig. 4) and at least one exterior surface (column 5, lines 6-11) and wherein said thermochromic composition is in thermal communication with at least a portion of said at least one exterior surface through said thermal moderator (Fig. 4). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to further modify the thermochromic label indicator of Kito et al., so as to include a thermal moderator, as taught by Parker, so as to provide a means for protecting the thermochromic composition against physical damage during use of the indicator.

Telatemp teaches a hot hand label indicator that consists of wherein a conspicuous color change reveals an indication that at least one exterior surface is of a temperature hot to human touch and wherein indicia is a warning indicia (The figure and the description following, "Indicator prevents burn injury to personnel from accidental contact with dangerously hot surfaces). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to further modify the thermochromic label indicator of Kito et al., so as to include a warning indicia, as taught by Telatemp, so as to provide increase awareness of the temperature being indicated during use of the indicator.

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It is noted that independent claim 9 states in the preamble a Jepson type claim, thus it is understood that the preamble is admitted prior art. Furthermore, the worklight is considered to be an appliance.

5. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kito et al., Parker and Telatemp, as applied to claims 9 and 11 as stated above, and further in view of Lerner (US 6,104,007).

Kito et al., Parker and Telatemp disclose a thermochromic label indicator as stated above in paragraph 4.

They do not disclose wherein at least one exterior surface is formed with a recessed area sized to receive an indicator such that the outer surface is substantially flush with said at least one exterior surface.

Lerner teaches a safety indicator that contains wherein at least one exterior surface is formed with a recessed area sized to receive an indicator such that the outer surface of the indicator is substantially flush with said at least one exterior surface (Fig. 13). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to further modify the thermochromic label indicator of Kito et al., Parker and Telatemp so as to include a recessed area, as taught by Lerner, in order to ensure a secure location for the indicator during use of the indicator.

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6. Claims 2-5 and 13-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kito et al. in view of Telatemp.

Kito et al. disclose a thermochromic label indicator including the following:

With respect to claims 13 and 2-5:

- a) an indicator providing an indication (column 2, lines 63-66), a layer of thermochromic coating composition in thermal communication with at least a portion of at least one exterior surface (column 37, lines 49-66), said thermochromic coating composition being formulated to undergo a conspicuous color change in response to heat from said at least one exterior surface during normal operation of an appliance (column 2, lines 63-66), said indicator being structured and arranged to display a message (column 14, lines 55-56), when said thermochromic coating composition undergoes said conspicuous color change (column 2, lines 63-66).
- b) further comprising a substrate (column 14, lines 51-61) wherein said layer is carried on said substrate (column 14, lines 51-61) and said substrate is disposed with respect to said at least one exterior surface so as to place said thermochromic coating composition in thermal communication with at least a portion thereof (column 14, lines 51-61);
- c) wherein said message is carried on said substrate (column 14, lines 51-61) and said layer of thermochromic coating composition is carried on said substrate so as to cover said message (column 14, lines 51-61), wherein said

thermochromic coating composition is normally opaque at room temperature so as to substantially obscure said message and turns transparent in response to said heat from said at least one exterior surface so as to expose said message (column 2, lines 63-66);

- d) wherein said substrate is transparent and said layer of thermochromic coating composition and said message are carried on the underside of said substrate (column 14, lines 51-61), whereby said substrate provides a protective covering for said thermochromic coating composition and message (column 14, line 62-68);
- e) wherein said thermochromic coating composition forms a layer on the underside of said substrate (column 14, lines 51-61), said message is applied to the underside of said layer and said substrate with said layer of thermochromic coating composition and message are adhered in position at said at least one exterior surface with the undersides thereof directed toward said at least one exterior surface (column 14, lines 51-61).

With respect to claim 14:

- a) an indicator providing an indication (column 2, lines 63-66);
- b) a substantially transparent substrate (column 14, lines 62-68);
- c) a layer of thermochromic coating composition and a message both underlying said substrate in overlapping relation with one another (column 14, lines 51-61);

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- d) said thermochromic coating composition being formulated to undergo a conspicuous color change in response to heat from said at least one exterior surface during normal operation of an appliance (column 2, lines 63-66);
- e) said thermochromic coating composition and said message being structured and arranged so that said message is not visible until said thermochromic coating composition undergoes said conspicuous color change (column 2, lines 63-66);
- f) said layer of thermochromic coating composition being in thermal communication with at least a portion of said at least one exterior surface for undergoing said conspicuous color change in response to heat from said at least one exterior surface (column 2, lines 63-66 and column 14, line 51 through column 15 line 15).

Kito et al. does not disclose wherein an indicator is a warning indicator that at least one exterior surface is of a temperature hot to human touch and wherein a message is a warning message that at least one exterior surface is of a temperature hot to human touch.

Telatemp teaches a hot hand label indicator that consists of wherein an indicator is a warning indicator that at least one exterior surface is of a temperature hot to human touch (The figure and the description following, "Indicator prevents burn injury to personnel from accidental contact with dangerously hot surfaces) and wherein a message is a warning message that at least one exterior surface is of a temperature hot to human touch (The figure and the description

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following, "Indicator prevents burn injury to personnel from accidental contact with dangerously hot surfaces). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to further modify the thermochromic label indicator of Kito et al., so as to include a warning indicia, as taught by Telatemp, so as to provide increase awareness of the temperature being indicated during use of the indicator.

It is noted that independent claims 13 and 14 state in the preamble, respectively, a Jepson type claim, thus it is understood that the preamble is admitted prior art. Furthermore, the worklight is considered to be an appliance.

7. Claims 8 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kito et al. and Telatemp, as applied to claims 2-5 and 13-14 as stated above, and further in view of Parker.

Kito et al. and Telatemp disclose a thermochromic label indicator as stated above in paragraph 6.

They do not disclose a thermal moderator disposed between a layer of thermochromic composition and at least one exterior surface and wherein said thermal moderator is in contact with said at least one exterior surface.

Parker teaches a thermally insulated warning indicator that consists of a thermal moderator (Fig. 4, insulator 20) disposed between a thermochromic composition (Fig. 4) and at least one exterior surface (column 5, lines 6-11) and wherein said thermal moderator is in contact

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with said at least one exterior surface (Fig. 4 and column 5, lines 6-11). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to further modify the thermochromic label indicator of Kito et al. and Telatemp, so as to include a thermal moderator, as taught by Parker, so as to provide a means for protecting the thermochromic composition against physical damage during use of the indicator.

With respect to claims 8 and 15: It has been held that the functional “whereby” statement does not define any structure and accordingly can not serve to distinguish. *In re Mason*, 114 USPQ 127, 44 CCPA 937 (1957).

### ***Response to Arguments***

8. Applicant's arguments filed on November 17, 2004 have been considered but are moot in view of the new ground(s) of rejection.

9. The declaration filed on November 17, 2004 has been considered. It was filed under 37 CFR 1.32, but since it dealt with “Swearing back of reference” according to the MPEP, it should have stated as being filed under 37 CFR 1.31. Furthermore, according to 37 CFR 1.31 (II) “An affidavit or declaration under 37 CFR 1.131 is not appropriate in the following situation:” (G) “Where applicant has clearly admitted on the record that subject matter relied on in the reference is prior art. In this case that subject matter may be used as a basis for rejecting his or her claims and may not be overcome by an affidavit or declaration under 37 CFR 1.131 *In re Hellsund*, 474 F.2d 1307, 177 USPQ 170 (CCPA 1973); *In re Garfinkel*, 437 F.2d 1000, 168 USPQ 659 (CCPA

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1971); *In re Blout*, 333 F.2d 928, 142 USPQ 173 (CCPA 1964); *In re Lopresti*, 333 F.2d 932, 142 (USPQ 177 (CCPA 1964). Therefore a Jepson claim (i.e. “the improvement comprising”) is considered admitted prior art.

### ***Conclusion***

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

The prior art cited on PTO-892 and not mentioned above disclose an indicator:

Pichon et al. (US 6,586,751 B1)

Khalidi (US 6,500,555 B1)

Balderson (US 4,983,810)

Kito et al. (US 4,554,565)

Yee et al. (US 4,339,951)

McNeely et al. (US 4,333,339)

Ferkel (US 1,676,536)

Wuensch (EPO 535563 A1)

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO**

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MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tania C. Courson whose telephone number is (571) 272-2239. The examiner can normally be reached on Monday-Friday from 8:00AM to 4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Diego Gutierrez, can be reached on (571) 272-2245.

The fax number for this Organization where this application or proceeding is assigned is (703) 872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR

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system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



DIEGO F.F. GUTIERREZ  
SUPERVISORY PATENT EXAMINER  
GROUP ART UNIT 2859

TCC  
February 10, 2005

CHRISTOPHER W. FULTON  
PRIMARY EXAMINER